IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants	:	Kenneth F. Carpenter, Jr. et al.
Application No.	:	09/773,883 Confirmation No. : 7944
Filed	:	January 31, 2001
For	:	INTERACTIVE TELEVISION APPLICATION WITH NAVIGABLE CELLS AND REGIONS
Art Unit	:	2623
Examiner	:	Scott E. Beliveau

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Pursuant to 1296 Off. Gaz. 2 (July 12, 2005), applicants request review of the rejection of claims 1-31 in the above-identified application. No amendments are being submitted with this Request. This Request is being filed with a Notice of Appeal.

Arguments begin on page 2 of this paper.

ARGUMENTS

I.   Introduction

Claims 66-91 are pending in this application.

Claims 66-68, 76-78, 86, 87, 89, and 90 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Eldering et al. U.S. Patent Pub. No. 2002/0026638 (hereinafter "Eldering") in view of the "IBM Technical Disclosure Bulletin" (hereinafter "IBM Bulletin"), in further view of Matthews, III U.S. Patent No. 5,815,145 (hereinafter "Matthews I"), and in further view of Matthews, III et al. U.S. Patent No. 6,025,837 (hereinafter "Matthews II").

Claims 69-71, 79-81, 88, and 91 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Eldering in view of the IBM Bulletin, in further view of Matthews I, in further view of Matthews II, and in further view of Lawler et al. U.S. Patent No. 5,585,838 (hereinafter "Lawler").

Claims 72-75 and 82-85 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Eldering in view of the IBM Bulletin, in further view of Matthews I, in further view of Matthews II, and in further view of Goldschmidt Iki et al. U.S. Patent No. 6,295,645 (hereinafter "Goldschmidt").

II.   Applicants' Reply to the 35 U.S.C. § 103(a) Rejections

Independent claims 66 and 76 are directed to a method and system for using an interactive application on a display screen to access content. At least two cells are provided on the display screen. Each of the at least two cells is operable to be associated with a television channel and to display, within the cell, video content being broadcast on the television channel. An indicator is displayed that notifies the user of the availability of interactive content associated with the television channel associated with the cell. The at least two cells are grouped into a region, and a region highlight is displayed that surrounds the cells in the region. A user is allowed to navigate the region highlight, wherein no cell highlight appears on the display while the user is navigating the region highlight. In response to a user selection of a region surrounded by the region highlight, a cell highlight is displayed around a cell in the selected region. The user is then allowed to navigate the cell highlight to each of the cells in the selected region, wherein only the cell that is surrounded by the cell highlight is in focus. Finally, the user is allowed to access the interactive content associated

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with the television channel for a cell for which an indicator is displayed and which is in focus.

A.   The Examiner's Reasons for Combining the References
In Fact Would Not Motivate One Skilled in the Art To Make
The Suggested Combination Because They Lack a Rational
Basis and Are Inapplicable to the Teachings of the References

Even assuming *arguendo* that the combination of Eldering, the IBM Bulletin, Matthews I, and Matthews II showed all of applicants' limitations recited in independent claims 66 and 76, the Office Action has still failed to meet its burden of establishing a *prima facie* case of obviousness because the motivations proffered in the Office Action lack any basis in fact and are inapplicable to the references.

The Office Action contends that it would have been obvious to modify Eldering to include the region highlight of the IBM Bulletin. *See* Office Action, page 5. The Office Action also contends that it would have been obvious to allow a user to navigate the newly added region highlight to a region in Eldering, wherein no cell highlight appears on the display while the user is navigating the region highlight. *See id.* The Office Action's purported motivation for making both of these modifications to Eldering is to "provid[e] feedback to the user as to which frame/region within the interface has input focus." *See* Office Action, p. 5. Applicants respectfully disagree and submit that the record is completely devoid of any reason why one skilled in the art would be motivated to modify Eldering in such a way as to add a region highlight or allow a user to navigate the newly added region highlight between regions.

Eldering merely states that different portions of the EPG may "comprise different frames in a frameset" (*Eldering*, ¶ 0040). Eldering is silent as to how a user navigates among the different windows within the EPG or even if the individual windows are selectable or navigable by the user. *See* Eldering, ¶¶ 0032, 0040-0044. Thus, the Examiner must initially modify Eldering—which the Examiner has not done—to make the windows navigable before the Examiner can even begin reasoning that a frame highlight is needed. But ignoring this fact, the Examiner's purported motivation of "providing feedback to the user as to which frame/region has input focus" is wholly inadequate to motivate one skilled in the art to navigate the Eldering EPG display by region using a region highlight. There are simply no navigable cells groupings in Eldering compatible with a region highlight. Each window is a single element. Eldering's discussion about frames at best puts each element within a different frame on a web page. There is no suggestion or teaching of multiple element frames. This is significant because, assuming a highlight were used within such an

embodiment, an element by element highlight would be used to provide focus, not a region highlight. In short, there is no need for a region highlight when there are no regions of multiple cells. The Examiner's motivation is patentably inapplicable here.

The Office Action's motivation to combine Eldering and the IBM Bulletin with Matthews I is equally deficient and unsupported by the references themselves. The Office Action merely contends that it would have been obvious to include the navigable region highlight of the Eldering/IBM Bulletin combination into the FIG. 4 display screen of Matthews I "for the purpose of taking advantage of the graphics-based nature of IT systems in association with the presentation of program guide services." *See* Office Action, p. 6. As discussed below, this motivation is far too conclusory to be sufficient as a matter of law. In addition, adding a region highlight to the FIG. 4 display screen of Matthews I is contrary to the very teachings of the Matthews I reference itself.

Matthews I approaches the problem of navigable regions in a completely different way—a way that negates the need for a region highlight. Namely, as shown in FIG. 6, a user in Matthews I may navigate a cursor within a programming tile strip (i.e., programming guide space 150 of FIG. 6) to cause "screen 98 to shift leftward in the programming guide space" (Matthews I, col. 10, ll. 11-25). Thus, screen 98 of FIG. 4 only displays one region (e.g., of six tiles) of a larger virtual display at a time—the region selected by the cursor in programming guide space 150. Since only one region is displayed in screen 98 at a time, there would be no reason for one skilled in the art to add a region highlight to navigate between regions in the display screen. Because Matthews I already provides a solution for navigating and selecting a grouping of programming tiles for display using the programming tile strip, the need for a region highlight is completely eliminated. Indeed, Matthews I would have to be completely redesigned to work with a region highlight.

Contrary to the Office Action's contention, applicants respectfully submit that there could be no possible motivation to include the region highlight from the Eldering/IBM Bulletin combination into screen 98 of Matthews I. The region highlight would serve no purpose nor add any functionality that does not already exist in Matthews I. Rather, applicants have recited a unique approach for grouping cells into regions and navigating between the regions using a region highlight in independent claims 66 and 76.

B.   The Examiner's Motivation to Combine the
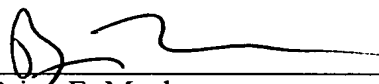   References Is Insufficient as a Matter of Law

Applicants also submit that the motivation proffered by the Examiner for combining the references is insufficient as a matter of law. It is well-settled that in order to

sustain a rejection under 35 U.S.C. § 103, the Examiner must point to some "objective teaching" to combine the references. *See, e.g., In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Examiner's dubious motivation of "taking advantage of the graphics-based nature of IT systems" is overly broad and generic. The mere fact that a system may be graphics-based does not specifically teach one skilled in the art to modify the references, especially not in the way the Examiner proposes. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to modify the references. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by *In re Gartside*, 53 USPQ2d 1769 (Fed. Cir. 2000). Rather, if the 35 U.S.C. § 103 rejection is to be maintained, the Examiner must provide some specific teaching in the references themselves or in the knowledge of one skilled in the art why one would be motivated to modify or combine the references. *See generally* MPEP § 2143. As shown above, one skilled in the art would have no motivation to combine any of the references in the way proffered by the Examiner. Accordingly, applicants request that the rejection under 35 U.S.C. § 103 be withdrawn.

III.   Conclusion

For the foregoing reasons, applicants submit that independent claims 66 and 76 are allowable over the prior art of record. Dependent claims 67-75 and 77-91, which contain all the limitations of independent claims 66 and 76, respectively, are allowable for at least the same reasons. Reconsideration and allowance are respectfully requested.

Respectfully submitted,

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